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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,185	09/29/2005	Snjezana Boger	016906-0432	1855

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FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
BASHORE, ALAIN L	

ART UNIT	PAPER NUMBER
1792	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/551,185	BOGER ET AL.	
	Examiner	Art Unit	
	Alain L. Bashore	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 May 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) *2-4,22-24,26 and 27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 5-21, 25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9-29-05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of claims 1, 5-21 and 25 in the reply filed on 5-30-08 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 2-4, 22-24, 26-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5-30-08.

Information Disclosure Statement

3. The information disclosure statement filed 9-29-05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The foreign patent documents crossed out were not considered unless listed on the attached PTO-892 form.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892 or listed and provided by applicant, they have not been considered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-9, 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "PSE" is not defined such as to render the term vague and indefinite. The term will be assumed to be as defined in claim 7.

Claims 12 and 13 lack antecedent basis for: "the metal salt" for claim 12; and "the CAB", "the ammonium salt" and "the potassium fluoride" all for claim 13. The recitations that lack antecedent basis will not be examined but further recitation in claims 12-13 examined as further defining the claim 1 recitation of "the modifying agent".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 8-9, 16, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over European patent application EP-0-163-471 to Fukuda et al (EP '471).

EP '471 discloses modifying a workpiece by treating a workpiece with a modifying agent at a temperature of between 40 and 700 °C. EP '471 teaches on page 13, lines 8-28, the treatment of a metallic wire by heating it to 80 °C, applying a calcium zinc phosphate solution (inherently a corrosion inhibitor) that is at a temperature of 80 °C.

The specific "particular" ranges claimed in the independent claim are considered obvious to one with ordinary skill in the art as design choice requirements depending on a particular result desired, in absence of unexpected results.

8. Claims 5-7, 11, 15, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '471 as applied to claims above, and further in view of British patent GB-863-098 (GB '098)

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GB '098 discloses a work piece modified by spraying (page 1, lines 34-35) that is provided at a temperature from 300-550 degrees Celsius (page 4, lines 50-55) and a modifying agent as an ammonium fluoride matrix including solvent (page 5, lines 20-25).

It would have been obvious to one with ordinary skill in the art to include spraying, at the temperature range claimed, or with the disclosed modifying agent (with matrix and further with solvent) for the purposes of a desired metallic surface result to be obtained in absence of expected results.

9. Claims 12-14, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '471 as applied to claims above, and further in view of Van Ooij et al.

Van Ooij et al discloses the modifying agent in aqueous phase with pH, further including other materials, and concentration considerations (col 5, lines 20-53; col 6, lines 8-18).

It would have been obvious to one with ordinary skill in the art to include the recitations of claims 12-14 because Van Ooij et al teaches pH and concentration adjustments important for metal treatment.

10. Claims 10 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '471 as applied to claims above, and further in view of Hanink.

Hanink discloses claims 10 and 25 (col 2, lines 5-10, 30-42).

It would have been obvious to one with ordinary skill in the art to include the recitations of claims 10 and 25 because Hanink teaches aluminum surface treatment.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP '471 as applied to claims above, and further in view of article entitles "Thermal modeling of controlled atmosphere brazing process using virtual reality technology" by Ratts et al (Ratts et al article).

The Ratts et al article discloses claim 20 (see abstract and paragraph one of the introduction).

It would have been obvious to one with ordinary skill in the art to include the recitations of claim 20 because it is known as an application of aluminum surface treatment the CAB brazed heat exchanger.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

13. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1, 6-19, 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4-6, 17, 19-32 of copending Application No. 11/576,918. Although the conflicting claims are not identical, they are not patentably distinct from each other because The specific temperature ranges, and the claiming of "thermally activated conversion of the coating raw material to form at least one, in particular continuous, covering layer, and cooling of the workpiece" to be well within one with ordinary skill of the art as obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alain L. Bashore/
Primary Examiner, Art Unit 1792